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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,847	12/21/2001	Thaylen K. Leany	03DV-9089	1175
7590	11/17/2003		EXAMINER	
John S. Beulick Armstrong Teasdale LLP Suite 2600 One Metropolitan Sq. St. Louis, MO 63102			MORRISON, NASCHICA SANDERS	
			ART UNIT	PAPER NUMBER
			3632	
DATE MAILED: 11/17/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/026,847	LEANY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Naschica S Morrison	3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 9/22/03 .

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_ .

## **DETAILED ACTION**

This is the third Office Action for serial number 10/026,847, Stud Mounting System, filed on December 21, 2001. Claims 1-20 are pending.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/22/03 has been entered.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,005,314 to Fisher et al. (Fisher) in view of Admitted Prior Art (APA) of Figure 1 in view of U.S. Patent 3,787,014 to Story et al. (Story) and further in view of U.S. Patent 4,933,809 to Boede et al. (Boede). With regards to claims 14, 16-18, and 20, Fisher discloses a motor comprising: a pair of endshields (58, 60); a cylindrical housing (54) extending between the endshields and having inner and outer surfaces; and a stator-rotor assembly (72, 80) mounted in the housing. Fisher does not disclose

the housing including a plurality of fasteners attached thereto and extending outwardly therefrom. The APA of Figure 1 discloses a motor comprising a housing (12) including a plurality of fasteners (20) spaced circumferentially about the housing and extending outwardly therefrom for attachment to a support. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing by providing a plurality of fasteners circumferentially spaced about the housing and extending outwardly therefrom because one would have been motivated to enable the motor to be attached within an application as taught by the APA of Figure 1 (lines 3-6 of page 1 of the instant specification). Fisher in view of APA of Figure 1 does not disclose the fasteners extending outwardly through openings in the housing. Story discloses a motor mount comprising a plurality of fasteners (66), inherently including a head, secured to the inner surface of the motor (by nuts as shown in Figure 2) and extending outwardly therefrom through attachment points/openings (56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing by providing openings therein as an alternative means for securing the fasteners to the motor as taught by Story (col. 3, lines 27-38) because one would have been motivated to prevent accidental "breaking off" of the fasteners. Fisher in view of APA of Figure 1 in view of Story does not disclose the openings in the housing being included in raised projections extending outwardly from the housing. Boede discloses an apparatus comprising a housing member (47) including a raised projection (58) defining a recess with an opening (56) therein, wherein a fastener (52) is attached to the inner surface of the recess. It would have been obvious to one of ordinary skill in

the art at the time the invention was made to have modified the housing by providing raised projections extending outwardly therefrom and including openings therein because one would have been motivated to eliminate mounting bolt head protrusion above the inner surface of the housing as taught by Boede (col. 4, lines 49-55). Fisher in view of APA of Figure 1 in view of Story and further in view of Boede does not teach the head of the fastener being substantially co-planar with the un-recessed portion of the inner surface of the housing. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the depth of the recess to be substantially equal to the height of the fastener head as is well known in the art such that the head is substantially co-planar with the un-recessed portion of the inner surface since it has been held since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. Regarding claims 1-3, the method steps recited therein are inherent to the apparatus as applied above.

Regarding claims 4 and 19, Fisher in view of APA of Figure 1 in view of Story and further in view of Boede does not disclose the fasteners secured to the housing inner surface by a weld, crimp, or adhesive. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the motor mount by substituting a weld, crimp, or adhesive for nuts attached to the fasteners (see Fig. 2 of Story) since welds, crimps, adhesives, and nuts are well known for their use in the fastening art and the selection of any of these known equivalents to secure the bolts to the housing surface would be within the level of ordinary skill in the

art. Specifically regarding claim 4, the method step recited therein is inherent to the apparatus as applied above.

Regarding claim 15, Fisher in view of APA of Figure 1 in view of Story and further in view of Boede does not disclose the raised projections spaced circumferentially 90 degrees about the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing by spacing the projections at 90 degree intervals about the housing since it has been held that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

Claims 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (APA) of Figure 1 in view of Story and further in view of Boede. With regards to claims 5, 6, 8-11 and 13, Fisher discloses a motor housing comprising: a pair of endshields (58, 60) and a cylindrical housing (54) extending between the endshields and having inner and outer surfaces. Fisher does not disclose the housing including a plurality of fasteners attached to the inner surface thereof and extending outwardly therefrom. The APA of Figure 1 discloses a motor comprising a housing (12) including a plurality of fasteners (20) spaced circumferentially about the housing and extending outwardly therefrom. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing by providing a plurality of fasteners circumferentially spaced about the housing and extending outwardly therefrom because one would have been motivated to enable the motor to be attached within an application as taught by the APA of Figure 1 (lines 3-6 of page 1 of the instant

specification). The APA of Figure 1 does not disclose the fasteners extending outwardly through openings in the housing. Story discloses a motor mount comprising a plurality of fasteners (66) secured to the inner surface of the motor (by nuts as shown in Figure 2) and extending outwardly therefrom through attachment points/openings (56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing by providing openings therein as an equivalent alternative means for securing the fasteners to the motor as taught by Story (col. 3, lines 27-38). The APA of Figure 1 in view of Story does not disclose the openings in the housing being included in raised projections extending outwardly from the housing inner surface. Boede discloses a motor mount comprising a housing member (47) including a raised projection (58) defining a recess with an opening (56) therein, wherein a fastener (52) is attached to the inner surface of the recess. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing by providing raised projections extending outwardly from the inner surface thereof and including openings therein because one would have been motivated to eliminate mounting bolt head protrusion above the inner surface of the housing as taught by Boede (col. 4, lines 49-55).

Regarding claim 7, the APA of Figure 1 in view of Story in view of Boede does not disclose the raised projections spaced circumferentially 90 degrees about the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing by spacing the projections at 90 degree intervals about the housing since it has been held that the optimization of

proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

Regarding claim 12, the APA of Figure 1 in view of Story in view of Boede does not disclose the fasteners secured to the housing inner surface by a weld, crimp, or adhesive. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the motor mount by substituting a weld, crimp, or adhesive for nuts attached to the fasteners (see Fig. 2 of Story) since welds, crimps, adhesives, and nuts are well known for their use in the fastening art and the selection of any of these known equivalents to secure the bolts to the housing surface would be within the level of ordinary skill in the art.

### ***Response to Arguments***

Applicant's arguments filed 9/22/03 have been fully considered, but are not persuasive.

Regarding applicant's argument that Story does not describe nor suggest a fastener configured to attach to an inner surface of a motor housing and extend outwardly through the housing, examiner respectfully disagrees. On the contrary, Story discloses the fasteners (66) extending through openings (56) within the motor housing (54) as found in column 3, lines 7-12 and 34-38.

Regarding applicant's argument that "Rather, Boede describes fasteners that are configured to attach to an outer surface of an electrical component and extend inwardly through the box", examiner respectfully disagrees. While the fastener (52) of Boede is

shown in an inwardly extending position for attachment to the housing member (28), the fastener itself is considered to be "configured" to attach to an inner surface of a motor housing and extend outwardly through the motor housing since the fastener includes a mounting head which permits the fastener to be attached to an inner or outer surface of a housing.

Regarding applicant's argument "the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching", examiner respectfully disagrees. The motivation and suggestion to combine the references has been adequately provided as found *in each* of the prior art references relied upon.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references themselves provide suggestion and motivation for the combinations and such motivations are specifically recited in the rejections above.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: 1930310 to Geyer; 2308962 to Riesing; 4952831 to Isozumi et al.; 5505423 to Kusijanovic; 5762313 to Siemer; 2001/0015586 to Honorio et al; 2002/0047406 to Jessberger; 2002/0117908 to Sanchez et al; 2002/0190593 to Franz et al; 6499714 to Wike; 6528916 to Naito et al; 2003/0067232 to Coonrod; 2003/0098622 to Lino; 6593674 to Sanchez et al.

The above references disclose fastener-mounts relevant to the present invention.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine telephone number for the Technology Center is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 872-9325.

*Naschica S. Morrison*  
Patent Examiner - Art Unit 3632  
11/7/03



Korie Chan  
Primary Examiner  
Art Unit 3632